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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/606,398

06/27/2003

Daniel R. Dwyer

10010003-2

1125

7590

05/05/2005

HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
P. O. Box 272400  
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EXAMINER

DO, AN H

ART UNIT

PAPER NUMBER

2853

DATE MAILED: 05/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/606,398

Applicant(s)

DWYER ET AL.

Examiner

An H. Do

Art Unit

2853

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 17-21 and 24-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-21 and 24-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

The Terminal Disclaimer and Amendment filed on 04 April 2005 have been acknowledged.

#### ***Terminal Disclaimer***

1. The terminal disclaimer filed on 04 April 2005 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent No. 6,557,992 has been reviewed and is accepted. The terminal disclaimer has been recorded.

#### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 17-21 and 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spencer et al (US 6,042,278) in view of Liang et al (US 5,701,230).

Regarding claim 17, Spencer et al disclose in Figures 1-4 an imaging device such as a printer (Figure 1, printers 10, 12, 14), comprising the step of printing decoration (Figure 3, demo images 54, column 2, lines 21-24) on a top surface of a decorative sheet (sheets of paper from printers 10, 12, 14).

Regarding claim 18, further comprising the step of selecting the decoration from a plurality of decorations (Figure 3, demo images 54).

Regarding claim 19, further comprising the step of providing the plurality of decorations on a memory device (Figure 3, memory 56).

Regarding claim 20, further comprising the step of downloading a decoration from a remote content source (column 2, lines 31-36).

Regarding claims 21 and 24, further comprising the step of designing a custom decoration (column 5, lines 18-25).

Regarding claims 24-27, the step of printing the user designed, custom decoration within a predetermined area of a larger media sheet (column 5, lines 18-40).

Spencer et al do not disclose the following:

Further regarding claim 17, the decorative sheet is placed behind the transparent door and oriented to be adjacent to the transparent door, whereby the decoration may be viewed through the transparent door.

Liang et al teach in Figure 5 the following:

Further regarding claim 17, the decorative sheet (picture or photograph, column 3, lines 12-13) is placed behind the transparent door (transparent lid member 26, column 2, line 60) and oriented to be adjacent to the transparent door (transparent lid member 26, column 2, line 60), whereby the decoration (picture or photograph, column 3, lines 12-13) may be viewed through the transparent door (column 3, lines 12-16).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to include a transparent door with a decoration placed behind, as taught by Liang et al into Spencer et al, for the purpose of identifying, enjoyment or convenience (column 3, lines 15-16).

***Response to Arguments***

4. Applicant's arguments filed 04 April 2005 have been fully considered but they are not persuasive. Applicant argued that Applicant is unable to locate any description or suggestion of a decorative sheet as disclosed and taught in neither Spencer et al nor Liang et al. This argument is not found persuasive because examiner interpreted the claims broadly and not into the disclosed specification. What applicant needs to clearly point out is that what kind of decorative sheet applicant is trying to claim. Spencer et al disclosed the demo images can be customized and updated as clearly noted in column 5, lines 18-25. Therefore, the demo pages as disclosed in Spencer et al is considered equivalent to the decorative sheet as in claimed invention.

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 2853

**Contact Information**

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to An H. Do whose telephone number is 571-272-2143. The examiner can normally be reached on Monday-Friday (Flexible).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen D. Meier can be reached on 571-272-2149. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



AD  
May 2, 2005



MANISH S. SHAH  
PRIMARY EXAMINER

5/2/05